

REMARKS

This communication is a full and timely response to the aforementioned non-final Office Action dated December 28, 2005. By this communication, claims 7 and 17 have been cancelled without prejudice or disclaimer of the underlying subject matter. Further, claims 1, 10, 11, and 18 have been amended, and claims 20 and 21 have been added.

Claim 1 has been amended to recite registration means for registering a unique e-mail address assigned to the e-mail transmission apparatus; comparing means for comparing the sending address input via the sending address means to the unique e-mail address; and address adding means for, when a sending address input via the sending address input means does not match the unique e-mail address registered by the registration means, adding the sending address to the receiving address list. Support for the subject matter added to claim 1 can be found variously throughout the specification and claims, for example, at page 10, lines 19-23 of the specification, and in original claim 7.

Each of claims 10 and 11 have been amended to recite registering a unique e-mail address assigned to a computer that is to execute the instructions; and comparing the input sending address to the unique e-mail address, adding the sending address to the receiving address list when the sending address does not match the unique e-mail address registered at the step of registering. Support for the subject matter added to claims 10 and 11 can be found variously throughout the specification and claims, for example, at lines 19-23 of the specification and in original claim 17.

Support for the subject matter recited in newly added independent claims 20 and 21 can be found variously throughout the claims, for example, original claims 1, 8, 9, 10, 18, and 19 where applicable.

Claims 1-6, 8-16, and 18-21 are pending.

Rejections Under 35 U.S.C. § 103

Claims 1-5, 7-8, 10-15, and 17-18 were rejected under 35 U.S.C. §103(a) as unpatentable over *Lytle et al* (U.S. Pub. No. 2002/0188683) in view of *Powers* (U.S. Pub. No. 2001/0034849). Applicant respectfully traverses this rejection.

Claims 1, 10, and 11 similarly recite, comparing means for comparing the sending address input via the sending address means to the unique e-mail address; and address adding means for, when a sending address input via the sending address input means does not match the unique e-mail address registered by the registration means, adding the sending address to the receiving address list.

Lytle discloses a process of creating a new e-mail address. In this process, a user creates a conventional e-mail address by identifying the recipient of a message answering a subject, and typing a body of the message. The Office Action acknowledges that *Lytle* fails to teach or suggest an address adding means that adds the inputted sender address to the receiving address list or a step that checks to see if a sending address is unique. See Office Action (Paper No./Mail Date 121122005) page 4, second pgph. The Office Action relies on *Powers* to remedy this deficiency.

Powers discloses the process for generating a graphical composition and delivery of conventional forms of written correspondence. In this process, a sender initiates correspondence in a variety of formats to multiple recipients or to a group of

recipients, wherein a security feature is provided that protects against unauthorized generation of correspondence by assumed SMTP e-mail identities, thereby presenting forgery of a correspondence from the sender. Sender identity security is provided wherein the disclosed process generates a proof copy of the correspondence e-mail back to the sender. The sender must retrieve this e-mail from his or her POP server with his or her e-mail program. *Powers*, however, fails to teach or suggest at least comparing the sending address input via the sending address input means to the unique e-mail address. In rejecting claims 7 and 17, the Office Action states, "a person knowledgeable in the art could utilize the principal behind identifying the unique recipient address to devise a method that identifies unique sender address that is not registered" (emphasis added). *Powers*, however, fails to provide any teaching or suggestion to support this position. As a result, it appears that the Office Action has improperly relied on hindsight reasoning to allege obviousness for this claim element.

The Federal Circuit has held that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious..." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). "The motivation to combine references can not come from the invention itself." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993). "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to

determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996).

In summary, *Lytle* and *Powers* either singly or combined fail to teach or suggest at least comparing the sending address input via the sending address input means to the unique e-mail address, such that the address adding means add the sending address to the receiving address list when the sending address input via the sending address input means does not match the unique e-mail address registered by the registration means, as recited in claims 1, 10 and 11. At best, the combined references teach that a proof copy of a correspondent's e-mail is sent back to the sender so that the sender must retrieve this e-mail from his or her POP server with his or her e-mail program. Accordingly, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys. V. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the above reasons, Applicant respectfully requests that the rejection of claims 1 and 18 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Claims 2-5 and 8 depend from claim 1, and claims 12-15 and 18 depend from claim 11. By virtue of this dependency, Applicant submits that claims 2-5, 8, 12-15, and 18 are allowable for at least the same reasons given above with respect to claims 1 and 11. In addition, Applicant submits that these dependent claims are

further distinguished over *Lytle* and *Powers* by the additional elements recited therein. Applicant respectfully requests, therefore, that the rejections of claims 2-5, 8, 12-15, and 18 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Claims 6 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over *Lytle* in view of *Powers* and further in view of *Collins et al* (U.S. Pub. No. 2002-0013817). Applicant respectfully traverses this rejection.

Claim 6 depends from claim 1 and claim 16 depends from claim 11. By virtue of this dependency, Applicant submits that claims 6 and 16 are allowable for at least the same reasons given above with respect to claims 1 and 11. In addition, Applicant submits that claims 6 and 16 are further distinguished over *Lytle*, *Powers* and *Collins* by the additional elements recited therein. Applicant respectfully requests, therefore, that the rejection of claims 6 and 16 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as unpatentable over *Lytle* in view of *Powers* and further in view of *Soroker et al* (U.S. Pub. No. 2002-0112010). Applicant respectfully traverses this rejection.

The Examiner acknowledges that *Lytle* and *Powers* fail to teach or suggest display means for displaying the receiving address and sending address contained in the receiving address list, as recited in claims 9 and 19, and relies on *Soroker* to remedy this deficiency.

Soroker discloses a method for processing an electronic mail message having an attachment, in which a display displays a list of all recipients of an email message. There is no indication that this "list of all recipients" includes the sending

address. Without any teaching or suggestion otherwise, the display feature taught by *Soroker* merely amounts to a conventional display technique.

In contrast, the elements recited in claims 9 and 19 provide a manner of restraining an illegal operation from spoofing a sender's email address by displaying the sending address in the receiving address list. As a result, a confirmation email message is sent to the sending address so that the true owner of the sending address can review the sent email message.

In summary, *Lylte*, *Powers*, and *Soroker* either singly or combined fails to teach or suggest display means as recited in claim 9 or the display step recited in claim 19. For at least this reason, Applicant requests that the rejection of claims 9 and 19, under 35 U.S.C. §103, be withdrawn and these claims be allowed. For the same reasons, new claims 20 and 21 are allowable over the references of record as well.


Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-6, 8-16, and 18-21 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of this application. In the event the application can be placed in even better form, Applicant request that the undersigned attorney be contacted at the number listed below.

Respectfully submitted,

BUCHANAN INGERSOLL PC

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